

## REMARKS

Claims 1, 4-11 and 22 are pending in the application. All pending claims stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Design Patent No. Des. 425, 375 to Parham. For the reasons set forth below, reconsideration of the application is respectfully requested.

### 1. Interview Summary

On October 4, 2007, applicant's representative Thomas conducted a telephonic interview with examiner Epps and the examiner's supervisor Friedman. Agreement as to patentable subject matter was not reached.

During the interview applicant's representative pointed out that the claimed invention is a method of displaying a used wine cork while simultaneously preventing residue on the cork from staining a surface on which the holder rests, with the method requiring the method steps of providing a wine cork display holder having a base and at least two sidewalls, and placing a cork from an opened wine bottle onto said wine cork display holder. Applicant's representative further stated that while the pending Office Action cited prior art that the Office contends could be used to hold a used wine cork, the cited prior art did not appear to teach or suggest the step of placing a cork from an opened wine bottle onto the cited structure. In fact, the cited prior art says absolutely nothing about wine corks.

Examiner's supervisor Friedman responded that the Office had conducted extensive searching but that no prior art teaching the method step of placing a used wine cork on any structure had been found. Examiner's supervisor Friedman further indicated, however, that the Office contends that it is known to place a used wine cork on a structure (as acknowledged by applicant's application where the Background section discuss the prior art of placing used wine

corks on plates or tablecloths), and that applicant's recited structural limitations were given no patentable weight in the absence of some showing that such structural limitations affect the claimed method.

Applicant's representative indicated that a Response would be filed, with the Response including arguments as to why the structural limitations present in the claimed method affect the efficacy and utility of the claimed method.

2. The Rejections Based on Parham '375.

Claim 1 has been amended to more particularly point out and distinctly claim the structural aspects of applicant's method of displaying a used wine cork while simultaneously preventing residue on the cork from staining a surface on which the holder rests. The claimed method includes two method steps: a) providing a wine cork display holder having a base and at least two sidewalls; wherein said at least two sidewalls comprises a pair of sidewalls having a length of between 0.25 inches and 4.0 inches and spaced between 0.5 inches and 1.5 inches apart; and b) placing a cork from an opened wine bottle into said wine cork display holder.

To highlight the way in which the structural limitations present in the claimed method affect the efficacy and utility of the claimed method, it should first be remembered that the prior art method of simply putting a used wine cork on a tablecloth or a plate had certain disadvantages as suggested (if not explicitly stated) by the specification as filed. In particular, the prior art method did not provide a well-contained receptacle for wine residue, so that residue would be difficult to clean-up and could soil the tablecloth, etc. In addition, the prior art method did not provide an aesthetically pleasing holder for the wine cork, which is often important to persons who value the rituals involved in opening and drinking fine wine.

To address those deficiencies of the prior art, the present invention is limited to the use of a wine cork holder having a base and at least two sidewalls, where the sidewalls have a length of between 0.25 inches and 4.0 inches and are spaced between 0.5 inches and 1.5 inches apart. That simple, yet relatively narrow, invention, provides a holder sized specifically to receive and artfully present a standard wine bottle cork, and to prevent any wine residue (which may be liquid or sediment) on the cork from contacting and soiling the surface on which the holder rests (such as the tablecloth of a restaurant or home, or other surface where wine is presented or displayed). With applicant's claimed method, the cork is presented in an aesthetically pleasing manner, and the residue is retained in a relatively small area to facilitate easy clean-up. Neither of those advantages is provided by the method(s) of the prior art. According, since applicant's claimed invention provides advantages not provided by the prior art, the application should be allowed.

In addition to the above, and as noted in prior responses to the Office in this case, it is respectfully submitted that Parham cannot make the claimed invention obvious since Parham is silent as to wine corks. Nothing in the Parham reference teaches or suggests anything about displaying used wine corks, and it is well established that each and every limitation of the claimed invention must be found someplace in the prior art to maintain a rejection under §103.

Moreover, it would not be obvious to modify the Parham apparatus by reducing the size of the Parham apparatus to a size appropriate to hold a small wine cork. As a matter of law it is not obvious to modify a reference when the modification would make the reference unsuitable for its intended purpose. See, e.g., MPEP 2143.01: If a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no

suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

In this case, the Parham apparatus would not be suitable for its intended purpose of holding a baby bottle if it were modified to the size required by, for example, claim 3.

For all of the above-stated reasons, the rejection under 35 U.S.C. 103(a) based on Parham should be withdrawn. The pending application is believed to be in a condition for allowance, and reconsideration of the application is respectfully requested.

Respectfully submitted,

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